

Serial No.: 08/845,897

PATENT APPLICATION
Docket No.: NC 77,987

REMARKS

Claims 1-25 are pending in the application. Claims 5, 6, 8-10, and 12-16 have been withdrawn pursuant to a restriction/election of species requirements. Claims 23-25 have been added by this amendment. No claims are presently allowed.

Claims 1, 21, and 22 have been amended to change "comprising" to "consisting essentially of" in reference to the composite, and to recite the composite optionally consists essentially of one or more additional components selected from a catalyst, a curing agent, a curing additive, and a release agent. Support for this amendment is found at page 8, lines 2-3 and page 10, lines 14-18.

New claims 23-25 recite that the composite consists essentially of the non-elastomeric polymeric matrix having therein a metal foam.

No new matter has been added.

Claim Rejections – 35 U.S.C. § 102

The Board of Patent Appeals and Interferences affirmed the rejection of claims 1-4, 7, 11, 19, and 22 under 35 U.S.C. § 102(b) as allegedly anticipated by Tsang et al. (US 4,605,595).

Tsang discloses a method of manufacturing a friction article. The method involves a metal foam and a filler, a friction modifier and a reinforcing fiber carried in a liquid binder drawn into the pores of the open foam structure until a desired density is obtained. Col. 1, lines 53-59.

In order to make a *prima facie* case of anticipation, the reference must disclose each limitation of the claim. *Verdegaal Bros. v. Union Oil Co. of California*, 2 U.S.P.Q.2d 1051, 1053, 814 F.2d 628, 631 (Fed. Cir. 1987); MPEP 2131. Among other deficiencies, the reference does not disclose the limitation in claims 1 and 22 that the composite consists essentially of a non-elastomeric polymeric matrix having therein a metal foam and optionally, one or more additional components selected from a catalyst, a curing agent, a curing additive, a release agent.

Independent claims 1 and 22 use the transitional phrase "consisting essentially of," which limits the scope of the claim to the specified materials and those that do not materially affect the basic and novel characteristics of the claimed composite (MPEP 2111.03). "Consisting essentially of" was added by this amendment and was not before the Board. A characteristic of the claimed subject matter is the acoustic damping properties, which are at least partly brought

Serial No.: 08/845,897

PATENT APPLICATION
Docket No.: NC 77,987

about by the damping properties of the polymeric matrix (p. 9, lines 8-9). The composite of Tsang includes a filler, a friction modifier and a reinforcing fiber. These additional materials would displace the polymer, resulting in less polymer being present and less ability for acoustic damping. Thus, a basic property of the claimed composite is materially affected by the extra ingredients of Tsang, placing Tsang outside the claimed scope.

Claims 2-4, 7, 11, and 19 depend from and contain all the limitations of claim 1. The arguments regarding the lack of *prima facie* for claim 1 are applicable to claims 2-4, 7, 11, and 19.

Claim Rejections – 35 U.S.C. § 103

The Board of Patent Appeals and Interferences affirmed the rejection of claims 17, 18, 20, and 21 under 35 U.S.C. § 103(a) as being allegedly unpatentable over Tsang.

In order to make a *prima facie* case of obviousness, each claim limitation must be disclosed in the references (MPEP 2143.03). As above, the reference does not disclose the limitation in claim 1 (claims 17, 18, and 20 dependent thereon) and 21 that the composite consists essentially of a non-elastomeric polymeric matrix having therein a metal foam and optionally, one or more additional components selected from a catalyst, a curing agent, a curing additive, a release agent. As all the claim limitations of claim 1 are not disclosed in the reference, a *prima facie* case of obviousness has not been made.

All other rejections were reversed by the Board.

In view of the foregoing, it is submitted that the application is now in condition for allowance.

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Serial No.: 08/845,897

PATENT APPLICATION
Docket No.: NC 77,987

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Respectfully submitted,



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